

11. (Amended) An article of footwear comprising:

an upper;

a sole layer attached to the upper, the sole layer having a ground engaging surface; and

a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.

37. (New) The sole of claim 1, wherein the mesh layer extends along substantially an entire length of a bottom surface of the sole layer.

38. (New) The article of claim 11, wherein the mesh layer extends along substantially an entire length of a bottom surface of the sole layer.

REMARKS

Claims 1-2, 5, 9-12, 15, and 19-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 5,237,758 to Zachman (hereinafter "Zachman"); claims 1-2 and 9-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 2,364,134 to Dow et al. (hereinafter "Dow"); claims 1-2, 6-7, 9-12, and 16-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 2,333,303 to Enos (hereinafter "Enos") or United States Patent Number 2,349,975 to Mackenzie (hereinafter "Mackenzie"); claims 3-4 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dow, Enos, or Mackenzie; and claims 7-8 and 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zachman in view of United States Patent Number 2,557,946 to Crooker (hereinafter "Crooker").

Applicants hereby cancel claims 21-36 without prejudice, amend independent claims 1 and 11, and add new dependent claims 37-38. Specifically, claims 1 and 11 are amended to recite a sole layer that has a ground engaging surface and to recite a continuous mesh layer that is partially embedded in the sole layer and partially exposed along the ground engaging surface. No

new matter has been entered thereby. Support for the amendments can be found at least in Applicants' specification at paragraphs 0014, 0019, 0022, 0027, and 0029, and in Applicants' FIGS. 1A, 1C-4A, and 5. Claims 37-38 are added to recite a mesh layer that extends along substantially an entire length of a bottom surface of the sole layer. No new matter has been entered thereby. Support for the new claims can be found at least in Applicants' specification at paragraphs 0015, 0021, 0027, and 0029, and in Applicants' FIGS. 1A, 2A, 3A, 4A, and 5. Claims 37 and 38 directly depend from amended independent claims 1 and 11, respectively, and, therefore, incorporate all of the respective limitations thereof.

Claims 1-20 are currently pending and presented for reconsideration. Claims 37-38 are added and presented for consideration. In view of the above amendments and following remarks, reconsideration and withdrawal of all grounds of rejection are respectfully requested.

1. Claims 1-2, 5, 9-12, 15, and 19-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Zachman. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Zachman appears to describe a safety shoe sole construction 10. The safety shoe sole construction 10 includes a flexible shoe sole 12 and a shoe upper 11 that is mounted on the shoe sole 12 and extends upwardly therefrom. At least one metallic fabric mesh web 15 is fully embedded between the top and bottom surfaces and the outer periphery 14 of the shoe sole 12. The metallic fabric mesh web 15 purportedly prevents inadvertent and accidental piercing of the shoe sole 12 by various foreign objects, such as nails, spikes, and the like. See, generally, column 3, lines 28-40, of Zachman.

In order for a claim to be anticipated under 35 U.S.C. § 102(b), each and every limitation of the claim must be found in a single reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See also, MPEP § 2131.

Applicants respectfully submit that Zachman fails to meet this exacting standard as applied to independent claims 1 and 11, as amended. Specifically, Applicants' amended independent claims 1 and 11 recite "*a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.*" In distinct contrast, Zachman does not teach or suggest such structure.

Specifically, the mesh web 15 of Zachman is fully embedded within the shoe sole 12 between its top surface and its bottom surface, and within its outer periphery 14. See, for example, column 3, lines 34-37, and FIGS. 1 and 2 of Zachman. Zachman fails to disclose "*a continuous mesh layer . . . partially exposed along the ground engaging surface.*"

Accordingly, Applicants respectfully submit that independent claims 1 and 11, as amended, are allowable over Zachman. Because claims 2, 5, 9-10, 12, 15, and 19-20 depend, either directly or indirectly, from either amended independent claim 1 or 11, Applicants respectfully submit that these claims are allowable as well. Reconsideration and withdrawal of the rejection of claims 1-2, 5, 9-12, 15, and 19-20 under 35 U.S.C. § 102(b) as being anticipated by Zachman are, therefore, respectfully requested.

2. Claims 1-2 and 9-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Dow. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Dow appears to describe soles for footwear that are, purportedly, satisfactory substitutes for soles of leather or of other known materials. A single sheet of a special fabric is filled on at least one side by plastic material. The fabric may be a woven fabric formed of sets of weft and warp threads. See, generally, lines 1-4 and 12-19 of the first column on page 1 of Dow. The fabric and the plastic material are united by heat and pressure to form a compacted finished sheet, from which soles may be cut. See, generally, lines 29-31 and 46-47 of the second column on page 1.

Like Zachman, Dow is also deficient as a proper anticipatory reference to independent claims 1 and 11, as amended, because Dow does not teach or suggest “*a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.*”

For instance, FIGS. 3-4, 6, and 8 of Dow are cross-sectional views of alternative embodiments of shoe soles. In contrast to Applicants’ claimed invention, FIGS. 3-4, 6, and 8 fail to show “*a continuous mesh layer . . . partially exposed along the ground engaging surface.*” Rather, in FIGS. 3-4, 6, and 8, a plastic material 8 is applied to the tread side of the fabric, such that the fabric is not “*exposed along the ground engaging surface.*” Dow is silent throughout the rest of its specification, failing to teach or suggest “*a continuous mesh layer . . . partially exposed along the ground engaging surface.*”

Accordingly, Applicants respectfully submit that independent claims 1 and 11, as amended, are allowable over Dow. Because claims 2, 9-10, and 12 depend, either directly or

indirectly, from either amended independent claim 1 or 11, Applicants respectfully submit that these claims are allowable as well. Reconsideration and withdrawal of the rejection of claims 1-2 and 9-12 under 35 U.S.C. § 102(b) as being anticipated by Dow are, therefore, respectfully requested.

3. Claims 1-2, 6-7, 9-12, and 16-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Enos or Mackenzie. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Enos appears to describe a sole that is produced by partially impregnating a fabric, which may be a woven fibrous structure, with a rubber or equivalent composition. Purportedly, the fabric imparts anti-slipping characteristics to the sole, while impregnation with rubber and the like enhances the strength of the fabric and affords protection against moisture. See, generally, lines 28-52 of the first column and lines 8-10 of the second column on page 2 of Enos.

Mackenzie appears to describe pile fabrics for use as reinforcement or support in rubber articles, as well as the rubber articles containing the pile fabrics. See, generally, lines 1-5 of the first column on page 1 of Mackenzie. The rubber articles can be used for tires, belting (e.g., transmission and conveyor), heels and soles for shoes, rubber tiles, mats, insulating blocks and mountings, etc. See, generally, lines 69-72 of the first column on page 3.

With respect to Enos, like Zachman and Dow, the reference fails to be a proper anticipatory reference to amended independent claims 1 and 11, because Enos does not teach or suggest *“a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.”*

First, Enos does not teach or suggest both a distinct mesh layer and a distinct sole layer. Absent a distinct mesh layer and a distinct sole layer, no mesh layer can possibly be embedded in a sole layer and, similarly, no mesh layer can possibly be exposed along a ground engaging surface of the sole layer. In other words, because Enos does not teach or suggest both a distinct mesh layer and a distinct sole layer, it can not, as a necessary consequence, and in fact does not, disclose “*a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.*” Moreover, even assuming, without deciding, that Enos does teach or suggest both a distinct mesh layer and a distinct sole layer, Enos does not teach or suggest the mesh layer being partially embedded in the sole layer.

Specifically, in Enos, FIGS. 1 and 2 are each a cross-sectional view of a partially impregnated fabric. The foundation 10 (*i.e.*, the fabric 10) is impregnated inwardly from its surface 12 with a flexible adhesive binder through a portion thereof, preserving its second surface 14 and its remaining portion 15 extending inwardly from the second surface 14 in their natural or original unimpregnated condition. See, for example, lines 1-4 and 21-31 of the second column on page 1 of Enos. As depicted in FIG. 3 of Enos, the fabric 10 is the sole layer of the illustrated article of footwear and the second surface 14 of the fabric 10 is the ground engaging surface of the sole layer. The fabric 10, as the sole layer of the illustrated article of footwear, can not also be, at the same time, a distinct mesh layer. Moreover, FIG. 3 does not depict, in addition to the fabric 10, a distinct mesh layer. Enos, therefore, because it does not teach or suggest both a distinct mesh layer and a distinct sole layer, necessarily fails to disclose “*a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.*”

Even assuming, without deciding, that the fabric 10 is a distinct mesh layer and that the region in FIG. 3 immediately above the surface 12 of the fabric 10 is a distinct sole layer, the fabric 10 is not shown to be partially embedded in that assumed sole layer. Rather, the surface 12 of the fabric 10 is shown to be flush with the region immediately above it. In distinct contrast to Applicants' claimed invention, Enos, therefore, even under such an assumption, does not disclose that the fabric 10 is "*a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.*" Moreover, under such an assumption, the assumed sole layer, because it is located immediately above the surface 12 of the fabric 10, lacks a ground engaging surface, as is required by Applicants' amended independent claims 1 and 11.

Second, an impregnated fabric clearly differs from an embedded mesh layer. An impregnated fabric is a fabric that is saturated with another substance. See, for example, page 908 of The American Heritage Dictionary of The English Language (3d ed. 1996). In distinct contrast, an embedded mesh layer is a mesh layer that is firmly placed in a surrounding mass. See, for example, page 600 of The American Heritage Dictionary of The English Language (3d ed. 1996). In Enos, the fabric 10 is only an impregnated fabric, *i.e.*, a fabric 10 saturated with a flexible adhesive binder. See, for example, lines 1-2 and 21-25 of the second column on page 1 of Enos. The impregnation of the fabric 10 with the flexible adhesive binder enhances the strength of the fabric 10 and affords protection against moisture. See, for example, lines 28-33 and 44-49 of the second column on page 1. In distinct contrast, Applicants' claimed invention is "*a continuous mesh layer partially embedded in the sole layer and partially exposed along the*

ground engaging surface.” In other words, in Applicants’ claimed invention, the continuous mesh layer is firmly placed in the surrounding sole layer.

With respect to Mackenzie, like Zachman, Dow, and Enos, the reference fails to be a proper anticipatory reference to amended independent claims 1 and 11, because Mackenzie does not teach or suggest ***“a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.”***

In Mackenzie, FIGS. 4, 6, and 8 illustrate rubber articles, from which heels and soles for shoes can be made, reinforced by pile fabrics, such as those shown in FIGS. 1-3, 5, and 7, respectively. In contrast to Applicants’ claimed invention, neither FIG. 4, nor FIG. 6, nor FIG. 8 shows ***“a continuous mesh layer . . . partially exposed along the ground engaging surface.”*** Rather, as illustrated, the pile fabrics are fully embedded in the rubber articles. See, also, for example, lines 38-42 of the first column on page 3 of Mackenzie. Mackenzie fails to disclose ***“a continuous mesh layer . . . partially exposed along the ground engaging surface.”***

As such, Applicants respectfully submit that amended independent claims 1 and 11 are not anticipated by Enos or Mackenzie. Because claims 2, 6-7, 9-10, 12, and 16-17 depend, either directly or indirectly, from either amended independent claim 1 or 11, Applicants respectfully submit that these claims are patentable as well.

In addition to the foregoing, Mackenzie also fails to disclose the further limitations of at least Applicants’ dependent claims 6-7 and 16-17. Applicants’ claims 6 and 16 recite, in part, that ***“at least a portion of the mesh layer extends beyond a bottom surface of the sole layer.”*** Applicants’ claims 7 and 17 recite, in part, that ***“the mesh layer is substantially coterminous with a bottom surface of the sole layer.”*** In sharp contrast, the pile fabrics of Mackenzie, as

described hereinabove, are completely enveloped by the rubber articles. Applicants respectfully submit that, for at least these reasons, dependent claims 6-7 and 16-17 are also independently patentable over Mackenzie.

Reconsideration and withdrawal of the rejection of claims 1-2, 6-7, 9-12, and 16-17 under 35 U.S.C. § 102(b) as being anticipated by Enos or Mackenzie are, therefore, respectfully requested.

4. Claims 3-4 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dow, Enos, or Mackenzie. Applicants respectfully traverse this rejection as applied to the claims, as amended.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 706.02(j).

Applicants respectfully submit that a prima facie case of obviousness has not been established with respect to claims 3-4 and 13-14, in view of the amendments to independent claims 1 and 11, respectively.

As discussed hereinabove in sections 2-3, neither Dow, nor Enos, nor Mackenzie teaches or suggests "*a continuous mesh layer partially embedded in the sole layer and partially*

exposed along the ground engaging surface.” Neither is there anything in the cited references, in their entirety, to suggest or motivate one skilled in the art to arrive at Applicants' claimed invention as recited in amended independent claims 1 and 11 and incorporated into dependent claims 3-4 and 13-14, respectively. Therefore, Applicants respectfully submit that claims 3-4 and 13-14 are allowable over Dow, Enos, and Mackenzie. Reconsideration and withdrawal of the rejection of claims 3-4 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over Dow, Enos, or Mackenzie are, therefore, respectfully requested.

5. Claims 7-8 and 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zachman in view of Crooker. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Crooker appears to describe a non-skid rubber sole construction. A sole 10 includes, on its outer surface, transverse ribs 12 spaced apart by transverse grooves 13. The ribs 12 have a rounded outer surface contour 14. Extending longitudinally within each of the transverse ribs 12 is a helical coil 15. The coil 15 is positioned within the rib 12 so that a side portion of the coil 15 is substantially flush with the outer rounded surface 14 of the rib 12. Purportedly, when one of the soles 10 is worn, the outer portions 14 of the ribs 12 wear. This wear exposes the outer portions of the coils 15 and thereby provides a plurality of road gripping elements exposed along the wearing surfaces of the ribs 12. See, generally, column 2, lines 18-32 and 44-50, of Crooker.

Applicants respectfully submit that the disclosure of Crooker fails to cure the deficiencies of Zachman with respect to amended independent claims 1 and 11, as explained in section 1 above. Specifically, Crooker fails to teach, suggest, or motivate one skilled in the art to

contemplate “*a continuous mesh layer partially embedded in the sole layer and partially exposed along the ground engaging surface.*” For example, Crooker does not even disclose a mesh layer. Rather, in distinct contrast to Applicants’ claimed invention, the reference merely describes a series of transversely disposed discrete helical coils 15. Moreover, even assuming, without deciding, that the helical coils 15 may be considered a mesh layer, the coils 15, as stated, are a series of transversely disposed discrete coils. Therefore, even under such an assumption, the helical coils 15 do not form a continuous mesh layer. Applicants, therefore, submit that neither Zachman nor Crooker, alone or in proper combination, provides the teaching, suggestion, or motivation for one skilled in the art to arrive at Applicants’ invention, as claimed in amended independent claims 1 and 11.

Further, it is well settled that, to combine references, there must be some suggestion or motivation to do so in the references themselves or in the knowledge generally available to one of ordinary skill in the art that lies outside the disclosure of the patent application. See, for example, MPEP § 2142. Absent this motivation, a rejection under 35 U.S.C. § 103(a) should not be maintained. As stated in MPEP § 2143.01, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990). As that section further states, “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” In re Mills, 916 F.2d at 682.

Moreover, as stated in MPEP § 2142, “[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima

facie case, the applicant is under no obligation to submit evidence of nonobviousness.” As further stated in that section, “[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” Ex parte Skinner, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). In particular, “the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.” In Re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting In Re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998)) (emphasis added). “The examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In Re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting In Re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)).

Applicants respectfully submit that the combination proposed in the Office action is legally deficient, because the Office action does not provide with specificity any facts or arguments to show that the nature of the problem or the knowledge of one of ordinary skill in the art would suggest the combination of Zachman with Crooker in the manner described in the Office action.

For at least these reasons, Applicants respectfully submit that independent claims 1 and 11, as amended, are allowable over Zachman in view of Crooker. Because claims 7-8 and 17-18 depend directly from amended independent claims 1 and 11, respectively, Applicants respectfully submit that these claims are allowable as well. Accordingly, Applicants respectfully request

reconsideration and withdrawal of the rejection of claims 7-8 and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Zachman in view of Crooker.

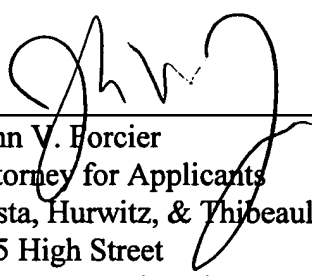
6. Applicants submitted a certified copy of the priority document, German Patent Application No. 10037728.9, at the time of filing the present application. To date, Applicants have not received acknowledgement of the receipt of the certified priority document. Please confirm receipt of the certified priority document in the next communication.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-20 and 37-38 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

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MARKED UP VERSION OF CLAIMS SHOWING AMENDMENTS

1. (Amended) A sole for an article of footwear, the sole comprising:
a sole layer having a ground engaging surface; and
a continuous mesh layer ~~at least~~ partially embedded in the sole layer and partially
exposed along the ground engaging surface.
11. (Amended) An article of footwear comprising:
an upper;
a sole layer attached to the upper, the sole layer having a ground engaging surface; and
a continuous mesh layer ~~at least~~ partially embedded in the sole layer and partially
exposed along the ground engaging surface.